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04/17/2001

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11/17/2006

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EXAMINER

STRANGE, AARON N

ART UNIT

PAPER NUMBER

2153

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/837,449

Applicant(s)

ELGEBALY ET AL.

Examiner

Aaron Strange

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7,8,10,21-24 and 31-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 8 and 10 is/are allowed.
- 6) ☒ Claim(s) 1-5,7,21-24 and 31-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. It is noted that claims 31-42 are substantially identical to claims 1-5,7,8,10 and 21-24 presented 3/6/2006. It is unclear if they were intentionally left unamended or if Applicant intended to amend the claims to correspond with the currently presented versions of claims 1-5,7,8,10 and 21-24. Since they have not been amended and no argument has been set forth in support of those claims, they remain rejected under the rationale set forth for claims 1-5,7,8,10 and 21-24 in the Office action of 5/19/2006.
2. Applicant's arguments filed 8/25/2006 have been fully considered but they are not persuasive.
3. With regard to claims 31-42, and Applicant's amendment to replace "machine-readable media" with "machine-accessible media", this amendment fails to overcome the rejection presented under 35 USC 101. Contrary to Applicant's assertion, no definition of "machine-accessible media" appears on page 18. At best, page 18 states that "machine-accessible media storing directives" "may be incorporated into" computers, PDA's, and cellular telephones.

Since the specification fails to define "machine-accessible media", and a piece of paper with code written on it is known in the art to be "machine-accessible", using technology such as optical character scanner or bar code readers. Since the claim is not limited to statutory subject matter, it is not statutory.

The Examiner recommends amending the claims to recite "Computer readable media having instructions stored thereon for" or a similar recitation.

4. With regard to claim 1, while the Examiner notes that Applicant has incorporated the subject matter formerly presented in claim 6 into claim 1, it is noted that the prior version of claim 6 was rejected under 35 USC 112, 2nd paragraph. That rejection has still not been overcome. Therefore, claim 1 is not in condition for allowance.

5. With regard to claim 21, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Applicant has merely provided a general assertion that "the Examiner's reliance on Fig. 12 and Page 20, Lines 2-20 is misplaced". The Examiner respectfully disagrees with this assertion, and claim 21 is rejected below.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-6,7 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. With regard to claim 1, the limitation "wherein the second machine is an endpoint to the communication session" is unclear. Based on Applicant's arguments, the session endpoints are the first machine and the second machine (Page 17, Lines 10-1 of Remarks filed 9/12/2005). Appropriate amendment or explanation is required. Applicant is encouraged to utilize terminology such as the terms added to claim 21, in order to clearly identify internal endpoints, external endpoints, NAT devices and registration servers, as appropriate.

9. With regard to claim 23, the limitation "the first session registration" in lines 9,10, and 11 is unclear. It is unclear if this is the same "first session registration" received in line 6 of claim 21 or a different session registration. If it is intended to be the same registration, it is unclear why it has been received twice. Appropriate amendment or explanation is required.

10. All claims not individually rejected are rejected by virtue of their dependency from the above claims.

Claim Rejections - 35 USC § 101

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claims 31-42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

13. The term "machine-accessible media" is not limited to statutory subject matter. The specification fails to define "machine-accessible media", and a piece of paper with code written on it is known in the art to be "machine-accessible", using technology such as optical character scanner or bar code readers. Since the claim is not limited to statutory subject matter, it is not statutory.

The Examiner recommends amending the claims to recite "Computer readable media having instructions stored thereon for" or a similar recitation.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 1-4 and 21-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Goldberg et al. (WO 02/03217 A1).

16. With regard to claim 1, while the claim remains unclear (discussed above), as best understood by the examiner, Goldberg discloses a method for establishing a communication session through a network translation device with a communication protocol utilizing a single communication port for setting up the communication session and transferring data the communication session, the method comprising:

preparing a session setup for a session with a first machine, the session setup identifying an internal origin address (internal IP address) and a first internal port to which the first machine (Client B) expects a response to the session setup (Page 6, Lines 21-23);

sending the session setup to a second machine (application server) through the network translation device, the second machine at least temporarily an endpoint to the communication session (Fig 12, and Page 20, Lines 2-10) and being configured to recognize if the session setup includes the internal origin address, and if so to associate with the first machine the routable external origin address of the network translation device (Page 6, Line 19 to Page 7, Line 9);

receiving by the first machine (Client B) a communication session initiation request from a third machine (Client A), said initiation having an associated external address/port for the third machine (Page 20, Lines 2-5); and

sending an acknowledgement to said initiation to the external address/port so as to prime the network translation device to receive the session from the third machine (Page 20, Lines 6-13).

17. With regard to claim 2, Goldberg further discloses sending content for the communication session from the first machine to the third machine, wherein the third machine is configured to wait for content from the first machine before the third machine sends content to the first machine (Page 20, Lines 28-30).

18. With regard to claim 3, Goldberg further discloses receiving data for the session from the third machine responsive to said priming (Page 20, Lines 15-18).

19. With regard to claim 4, Goldberg further discloses that the protocol comprises modification to an original communication protocol (SIP) requiring utilizing different communication ports for setting up the communication session and transferring data during the communication session (Page 19, Lines 21-32).

20. With regard to claim 21, Goldberg discloses a method for an endpoint internal to a network translation device to set up a communication session with an endpoint external to the network translation device, the method comprising:

contacting a registration server to resolve an alias for the external endpoint (INVITE/SDP is sent to app server);

receiving a first session registration from the registration server (INFO/NAT message is received from app server), the first session registration comprising a routable network address for the external endpoint, and a content port to which content for the second external endpoint should be sent (Page 20, Lines 13-15); and

modifying a protocol for the communication session requiring the internal endpoint to complete setting up the communication session and await receiving content from the external endpoint (Fig 12 and Page 20, Lines 16-30), said modifying including configuring the first end point to prime the network translation device by sending at least one network packet to the external endpoint at the routable address on the content port before said completing setting up the communication session with the external endpoint (Send RTP/NAT message) (Page 20, Lines 2-30 and Fig 12); and

after said priming the network translation device, receiving content for the communication session on the content port (Page 20, Lines 28-29).

21. With regard to claim 22, Goldberg further discloses sending a second session registration for the internal endpoint to the registration server, the second session registration comprising an embedded network address for the internal endpoint that is non-routable (Page 19, Lines 18-20).

22. With regard to claim 23, Goldberg further discloses that the registration server receives session registrations from both the internal and external endpoints. The server first determines which endpoints are located behind a NAT (at least Page 19, Lines 12-

20; Fig 2). While Goldberg fails to specifically disclose that the devices are registered, this limitation is inherent, because the server provides the appropriate addressing information to each endpoint when assisting with the connection setup (Page 20, Lines 2-30).

23. With regard to claim 24, Goldberg further discloses that the registration server is configured to identify the non-routable network address within the second session registration, and responsive to said identifying, registering the internal endpoint with respect to a routable address associated with the network translation device (Page 19, Lines 14-20).

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg et al. (WO 02/03217 A1) in view of Fallentine et al. (US 2002/0042832).

26. With regard to claim 5, while the system disclosed by Goldberg shows substantial features of the claimed invention (discussed above), it fails to disclose that

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the session setup includes an alias and a registration server receiving the session setup and registering the first machine with respect to the alias and its' external origin address.

Fallentine teaches a method of registering endpoints of a communication session which reside behind a NAT using the IP address and alias of the endpoint. This would have been an advantageous addition to the system disclosed by Goldberg since it allows unique aliases to be used to identify each endpoint for session identification (¶48).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to register endpoints with respect to their external origin addresses and aliases, in order to provide unique identifiers for session identification.

Allowable Subject Matter

27. Claims 8 and 10 are allowed.

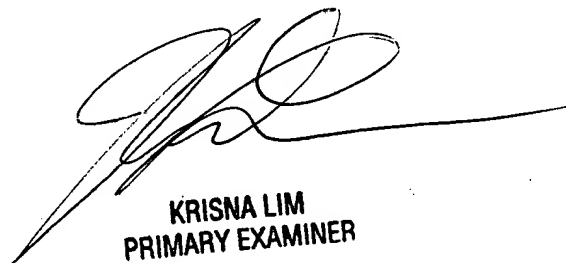
Conclusion

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Strange whose telephone number is 571-272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AS
11/11/2006



KRISNA LIM
PRIMARY EXAMINER